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EXAMINER
POLLACK, MELVIN H

ART UNIT	PAPER NUMBER
2142	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/551,364	SIMONOFF, ADAM J.	
	Examiner	Art Unit	
	Melvin H Pollack	2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 April 2000* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-77* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-77* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *2* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☒ Other: *see attached office action* .

DETAILED ACTION

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 34-38 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 4-7, 9 of prior U.S. Patent No. 6,351,777. This is a double patenting rejection.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 21, 25, 35 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5, 13 of U.S. Patent No. 6,463,460. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the application contain every limitation in their respective claims of the

U.S. patent, and add no new limitations over the patent claims, but lack at least one limitation from the patent.

5. Claims 22-24, 26-30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-4, 6, 7, 10-12 respectively, of U.S. Patent No. 6,463,460. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are word-for-word copies of each other, and are derived from obvious-type DP claims.

6. Claims 31, 48 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 18 of U.S. Patent No. 6,351,777. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the application contain every limitation in their respective claims of the U.S. patent, and add no new limitations over the patent claims, but lack at least one limitation from the patent.

7. Claims 32, 33, 49, 52 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2, 3, 19, 20, 22 respectively, of U.S. Patent No. 6,351,777. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are word-for-word copies of each other, and are derived from obvious-type DP claims.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 1-6, 13, 14, 20-22, 25, 27-30, 34-37, 48-53, 55-58, 63, 64, 66-68, 72, 74-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aditham et al. (6,378,001) and Kumar et al. (6,342,906).

10. For claim 1, Aditham teaches a method (see abstract) facilitating collaboration (col. 1, lines 15-20) between a plurality of users (col. 1, lines 20-25) of incompatible hardware and/or operating systems (Fig. 2 & 3, and col. 3, line 65 – col. 4, line 30), comprising:

a. Selectively generating (col. 2, lines 32-33) shared objects (col. 5, lines 47-48) which are displayable at user-selected locations (Fig. 10) on a White Board screen of one of the users (col. 2, lines 20-23);

b. Transmitting all generated ones of the shared objects for selective distributions to each of the other users (col. 2, lines 20-25); and

c. Filtering the shared objects to thereby permit selective retransmission of the shared objects to respective ones of the other users (col. 2, lines 25-30).

11. Aditham does not expressly disclose what the shared objects are, beyond the generic expression that they are information shared by various users for the purpose of collaboration. Several examples are given, such as a spreadsheet (see above) or a database record (col. 1, lines 20-40), but there is no list of all the possible objects. However, the applicant's list of objects are all well-known in the art as methods of imparting information, consisting of generic multimedia data, text, HTML and hyperlinks, active track objects, freehand drawings and other images, and

3D images. The decision as to the format of the object is a design choice, and the choosing of any particular object type would not destroy the reference.

12. Kumar teaches that the shared object can be of one or more types of the list given by the applicant (col. 3, lines 45-52). Kumar also teaches many of the limitations in claim 1 (abstract, Fig. 5, col. 1, lines 5-10). At the time the invention was made, one of ordinary skill in the art would have known that the shared objects could be any of the above types because of the reasons above, their ubiquitous presence throughout the body of art, and in order to allow a broad array of possible collaborative applications (col. 2, lines 15-17).

13. As for claim 2, Aditham teaches that one of the respective ones of the other users is a new user (col. 2, lines 25-30).

14. As for claims 3-5, Aditham teaches that the users have predetermined privilege level, and that users receive some of the objects if they have the level (col. 5, lines 19-57). It would be obvious to skip the filtering step if all users had an identical privilege level, as an identical level would reduce mean that every user could receive every object, and would occur directly from the implementation of claim 4. Further, such a situation occurs during a "public" session.

15. As for claim 6, Kumar teaches the use of a multimedia presentation (see claim 1 discussion above).

16. Claim 13 is drawn to many of the limitations detailed in claim 1. Claim 13 adds the limitation of a server collecting objects from a client for retransmission to other clients, which Aditham also shows (Fig. 3). If claim 1 is rejected, then claim 13 is also rejected for the reasons above.

17. Claim 14 is drawn to the same limitations drawn in claim 2. If claim 2 is rejected, then claim 14 is also rejected for the reasons above.

18. As for claim 20, Aditham teaches that the generated object comprises an object sequence, and wherein each member of the object sequence is different than all other members of the object sequence (Fig. 6).

19. Claim 21 is drawn to many of the limitations detailed in claim 13. Claim 21 adds several limiations that Aditham also teaches: the use of a GUI (col. 1, lines 40-50 and col. 4, lines 56-60), the method of logging into a session (col. 4, line 66 – col. 5, line 2) to receive a unique ID (col. 4, lines 34-36), and the server providing a command to update a computer that just joins in (col. 2, lines 24-26).

20. As for claim 22, Aditham teaches that the network is a LAN (col. 3, lines 60-61).

21. Claim 25 is drawn to a White Board system that implements the limitations drawn in claims 13 and 3. The art teaches that a system implementation is functionally equivalent to the underlying method. Therefore, if claims 3 and 13 are rejected, then claim 25 is also rejected for the reasons above.

22. Claims 27 and 28 are similar to the limitations drawn in claim 4. Claims 29 and 30 are drawn to the same limitations drawn in claims 6 and 5, respectively. If claims 4-6 are rejected, then claims 27-30 are also rejected for the reasons above.

23. Claims 34 and 35 are drawn to machine readable code stored in memory for implementing the limitations in claim 21. The prior art teaches that a software implementation is functionally equivalent to a hardware implementation. Official notice is taken regarding the fact

that computer code is stored in memory. Therefore, if claim 21 is rejected, then claims 34 and 35 is also rejected for the reasons above.

24. Claim 36 is drawn to machine readable code stored in memory for implementing the limitations in claim 27. Claim 37 is drawn to machine readable code stored in memory for implementing the limitations in claims 20 and 29. The prior art teaches that a software implementation is functionally equivalent to a hardware implementation. Official notice is taken regarding the fact that computer code is stored in memory. Therefore, if claims 20, 27, and 29 are rejected, then claims 36 and 37 are also rejected for the reasons above.

25. Claims 48 and 49 are drawn to many of the same limitations as claim 34. Claims 51 and 52 are drawn to many of the same limitations as claims 38 and 40. If claim 34 is rejected, then claims 48 and 49 are also rejected for the reasons above.

26. Claims 50 and 53 are drawn to machine readable code stored in memory for implementing the limitations in claims 20 and 9, respectively. The prior art teaches that a software implementation is functionally equivalent to a hardware implementation. Official notice is taken regarding the fact that computer code is stored in memory. Therefore, if claims 9 and 20 are rejected, then claims 50 and 53 are also rejected for the reasons above.

27. Claims 55-58 are drawn to many of the same limitations as claims 2, 1, 3, 4, respectively. If claims 1-4 are rejected, then claims 55-58 are also rejected for the reasons above.

28. Claim 63 is drawn to many of the same limitations as claims 48 and 56. Claims 64, 66, 67 and 68 are drawn to many of the same limitations as claims 55, 20, 21 and 22, respectively. If claims 20-22, 48, 55 and 56 are rejected, then claims 63, 64 and 66-68 are also rejected for the reasons above.

29. Claims 72 and 74-77 are drawn to many of the same limitations as claims 25 and 27-30, respectively.

30. Claim 7 rejected under 35 U.S.C. 103(a) as being unpatentable over Aditham and Kumar as applied to claims 1-6 above, and further in view of Smythe et al. (6,418,214).

31. For claim 7, Aditham shows that a client can log on and off (Fig. 10, #46 and #52). Smythe teaches in further detail the step of shutting down at least one of the White Board clients responsive to a received command signal, where the signal can be local (col. 10, lines 43-47) or remote (col. 10, lines 54-60). Further evidence is also presented by Smythe (Fig. 7, col. 6, lines 5-10, col. 11, lines 40-55). At the time the invention was made, one of ordinary skill in the art would have used the shutdown process of Smythe to better handle the Aditham system.

32. Claims 8-12, 15-19, 23, 24, 38-40, 45-47, 54, 60-62, 69, 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aditham and Kumar as applied to claims 1-6 above, and further in view of England (6,144,991).

33. England teaches many of the limitations in claim 1 (abstract), including the development of whiteboards and other collaborative tools in the web environment (col. 5, lines 35-55) so that one computer may develop objects and transmit them to other computers (col. 8, lines 10-30) and to retransmit them to computers joining in (col. 29, lines 38-58).

34. For claim 8, England teaches that the operation of a first active hyperlink on a first White Board client causes selected other ones of the White Board clients to display the file specified by the URL associated with the first active hyperlink (col. 10, lines 39-52). At the time the

invention was made, one of ordinary skill in the art would have given Aditham this form of collaborative method in order to allow collaboration relationships such as between an expert and a student (col. 6, lines 38-50).

35. For claims 9-12, England teaches that the White Board session may be saved in a session file and reconstructed from said file for new users (col. 8, lines 40-53, and col. 22, lines 15-45). One of ordinary skill in the art would recognize a web page as a possible storage format, especially for web-based systems. Aditham teaches the storage of the session (col. 1, lines 50-60). At the time the invention was made, one of ordinary skill in the art would have used England to flesh out the implementation, especially in a web environment.

36. Claims 15-19 are drawn to the same limitations drawn in claims 9-12. If claims 9-12 are rejected, then claims 15-19 are also rejected for the reasons above.

37. For claims 23 and 24, Aditham teaches that the server can distribute programs over the web (col. 13, lines 25-30) and the use of JAVA applets to develop the White Board and communication (col. 4, lines 40-50 and col. 7, line 40 – col. 8, line 22). England goes further to show the use of web browsers (Fig. 3) and a web server that serves web pages (col. 2, lines 30-40).

38. Claim 38 is drawn to machine readable code stored in memory for implementing the limitations in claim 17. Claims 39, 40 and 45 are drawn to machine readable code stored in memory for implementing the limitations in claims 16, 17, and 9, respectively. The prior art teaches that a software implementation is functionally equivalent to a hardware implementation. Official notice is taken regarding the fact that computer code is stored in memory. Therefore, if

claims 9, 16 and 17 are rejected, then claims 38-40 and 45 are also rejected for the reasons above.

39. As for claims 46 and 47, Kumar teaches the use of a chat function and storage of the conversation (Fig. 4, #904-912), which can be replayed later (col. 8, lines 40-53, and col. 22, lines 15-45). At the time the invention was made, one of ordinary skill in the art would have added a chat feature to Aditham and Kumar so that users could improve their communication during collaboration products.

40. Claim 54 is drawn to many of the same limitations as claim 45. If claim 45 is rejected, then claim 54 is also rejected for the reasons above.

41. Claims 60-62 are drawn to many of the same limitations as claims 10-12, respectively. If claims 10-12 are rejected, then claims 60-62 are also rejected for the reasons above.

42. Claims 69 and 70 are drawn to many of the same limitations as claims 23 and 24. If claims 23 and 24 are rejected, then claims 69 and 70 are also rejected for the reasons above.

43. Claims 26, 59, 65, 71 and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aditham and Kumar as applied to claims 1-6 above, and further in view of Raz (6,292,827).

44. For claim 26, Raz teaches the use of multiple servers for the purpose of redundancy and fault tolerance (i.e. if one server goes down, the others take over) (col. 7, lines 17-20).

45. As for claim 59, Raz teaches using JPEG to store data (col. 11, lines 5-22). At the time the invention was made, one of ordinary skill in the art would have used JPEG as a standard file format in order to compress the image data.

46. Claim 65 shares many of the limitations as claim 59. If claim 59 is rejected, then claim 65 is also rejected for the reasons above.

47. As for claim 71, Raz teaches that the client applet instantiates a plug-in (col. 10, lines 36-49 and col. 12, lines 5-35) conforming to a predetermined application programming interface (API) (col. 10, line 50 – col. 11, line 3 and col. 12, lines 51 – 61). At the time the invention was made, one of ordinary skill in the art would have used the information from Raz to flesh out Aditham's agents, which act like plug-in APIs, and translate it to the web environment.

48. Claim 73 is drawn to many of the same limitations as claim 26. If claim 26 is rejected, then claim 73 is also rejected for the reasons above.

49. Claims 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aditham and Kumar as applied to claims 1, 3, and 4 above, and further in view of the WWW Conference Article by Jacobs et al. Further proof is provided by Pizano et al. (6,105,055) and Honda (6,020,885).

50. Claim 31 is drawn to machine readable code stored in memory for implementing the limitations in claim 1. Claim 31 is also drawn to the development of separate tools for each type of data object listed in claim 1.

51. The prior art teaches that a software implementation is functionally equivalent to the underlying method. Official notice is taken regarding the fact that computer code is stored in memory.

52. It has already been shown that Aditham and Kumar teach the generation of these objects (claim 1 discussion). Neither expressly teaches the tools to develop these object types.

However, it would be obvious to add a tool to generate an object of a certain type to an invention that already calls for the generation of an object of a certain type. The examiner also notes that, just as the generation of all the object types are well known in the art, so are the tools to affect the generation of said objects.

53. Fig. 5 of the Jones article shows that a whiteboard contains many object tools including placement tools for images, freehand drawings, text, etc. Any other related tools not shown by this evidence is considered by the examiner to be a design choice that would easily be added without destroying the invention.

54. Honda is drawn to a whiteboard that specializes in the development of 3D objects (abstract, Fig. 5).

55. The applicant is also directed to Pizano (abstract), which teaches many of the limitations drawn in claim 1 (summary of the invention). In this case, Pizano shows an advanced whiteboard (Fig. 3, 7) that has not only the tools shown above, but advanced tools for predetermined objects and track objects (col. 2, lines 60-67, and col. 4, lines 18-26).

56. Therefore, for the reasons above and for the reasons shown in claim 1, claim 31 is also rejected.

57. Claims 32 and 33 are drawn to machine readable code stored in memory for implementing the limitations in claims 4 and 3, respectively. The prior art teaches that a software implementation is functionally equivalent to the underlying method. Official notice is taken regarding the fact that computer code is stored in memory. Therefore, if claims 3 and 4 are rejected, then claims 32 and 33 are also rejected for the reasons above.

58. Claims 41-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aditham, Kumar and England as applied to claim 39 above, and further in view of Howell et al. (5,276,901).

59. For claims 41-44, Howell teaches storage of information at a privilege level of the user under various methods (abstract, Fig. 4, col. 1, lines 15-22, col. 2, lines 18-55). It has been shown above that Aditham uses privilege level information. At the time the invention was made, one of ordinary skill in the art would have used Howell to learn how to produce the information that Aditham requires.

Conclusion

60. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin H Pollack whose telephone number is (703) 305-4641. The examiner can normally be reached on 8-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark R Powell can be reached on (703) 305 - 9703. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800.

MHP
March 21, 2003

ROBERT B. HARRELL
PRIMARY EXAMINER